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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,398	11/28/2001	Jai K. Baek	212/340	3095

7590

09/30/2005

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,398

Applicant(s)

BAEK, JAI K.

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9-16 and 18-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porcher 4,702,022 in view of Dalvy et al. 5,924,218, Mashita et al. 5,681,649 and Finn 3,410,004. Porcher discloses all the limitations substantially as claimed including the following: a liner with multiple resilient layers (see Figure 3A especially, showing an inner liner, a resilient layer on top of the inner liner; a second resilient layer on top of the first resilient layer, and at least an outer cover layer, all shown in the heel and forefoot areas.). All the layers of the liner boot, including the vacuum layer, are provided to make the boot more comfortable on the user's foot and to protect the user's foot during use. Porcher '022 does not disclose a gel pad located between any of the layers in the toe box area or the heel area. Dalvy et al. '218 teaches that a gel pad 5 can be located between the layers of an inner boot (especially in the heel area as shown in Figure 1) to aid in protecting the user's foot and to help in cushioning the user's foot and fitting the boot to the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, in view of Dalvy et al. '218, to place a gel pad in the heel area of the liner of Porcher '022 to aid in protection and comforting the user's foot within the boot. Mashita et al. '649 teaches that a gel pad, made of styrene and butadiene, can be located in many areas of footwear including the toe box area, to aid in cushioning and protecting the user's

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foot. Therefore, it would have been obvious to place a gel pad in the toe box area, as taught by Mashita et al. '649, between any of the layers of the toe box to aid in cushioning, protecting and comforting the user's foot within the boot. Finn '004 further supports Mashita et al '649 by showing that resilient pads 14 can be located in the toe and heel areas of a shoe to aid in fitting the inner lining to the shape of the user's foot. With respect to the different Shore A hardnesses of the toe box and heel counter, it appears that it would have been a mere matter of testing and optimization to find a combination of material that would provide the desired comfort and protection that would meet the desired total hardness of different areas of the boot.

Response to Arguments

3. Applicant's arguments filed July 13, 2005 have been fully considered but they are not persuasive. Applicant argues that a prima facie case has not been established because "The teaching or suggestion to make the claimed combination and the reasonable expectation of success **must both be found in the prior art...**" (emphasis added). The reason to combine can come from the prior art itself or what the prior art, as a whole, teaches one of ordinary skill in the art. In the rejections set forth above, the reasons to combine come from both, what the references, as a whole, teach as well as what one of ordinary skill in the art would glean from the references if they were placed in front of him. It appears applicant is arguing the reference separately rather than what the references teach, as a whole.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "Anthony Stashick". The signature is fluid and cursive, with the first name "Anthony" and last name "Stashick" clearly distinguishable.

Anthony Stashick
Primary Examiner
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ADS